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09/365,426	08/02/1999	PETER HARTMAIER	OPWR.092PA	1765
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Wilson Ham & Holman 1811 Santa Rita Road, Suite 130 Pleasanton, CA 94566			EXAMINER FELTEN, DANIEL S	
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* PETER HARTMAIER
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11 Appeal 2009-011489
12 Application 09/365,426
13 Technology Center 3600
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16 Before JAMES D. THOMAS, ANTON W. FETTING, and
17 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
18 FETTING, *Administrative Patent Judge*.

19 DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Peter Hartmaier (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 12-14, 23, 29-32, and 34-40. These claims, along with claim 15 which is allowed, are the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellant invented a way of replenishing prepaid accounts (Specification 1: Technical Field). An understanding of the invention can be derived from a reading of exemplary claim 29, which is reproduced below [bracketed matter and some paragraphing added].

29. A method of providing prepaid account services to consumers comprising the steps of:

[1] assigning prepaid accounts to said consumers;

[2] associating said prepaid accounts with wireless telephones;

[3] communicating with a banking network regarding consumer replenishment transactions,

[4] wherein said communicating with said banking network step further comprises the steps of:

[5] receiving transaction messages following individual replenishment transactions by said consumers,

² Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed January 3, 2006) and Reply Brief ("Reply Br.," filed June 1, 2006), and the Examiner's Answer ("Ans.," mailed March 23, 2006).

[6] wherein said receiving transaction messages step further comprises:

[7] verifying location identification information associated with received transaction messages, wherein said location identification information identifies authorized replenishment locations;

[8] receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period;

[9] reconciling said individual transactions; and

[10] sending a message indicating the disbursement of funds associated with said replenishment transactions;

[11] communicating with a prepaid engine regarding said consumer replenishment transactions; and

[12] sending a disbursement message to said banking network,

[13] wherein said disbursement message comprises

[14] information regarding the distribution of funds associated with said replenishment transactions.

The Examiner relies upon the following prior art:

Taskett	WO 97/04579	Feb. 6, 1997
Taskett	WO 98/25237	Jun. 11, 1998
Hanson	WO 98/34393	Aug. 6, 1998

Claims 29-32, 34, and 12-14 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.³

Claims 12-14, 23, 29-32, and 34-40 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Taskett '237, Taskett '579, and Hanson.

ISSUES

The issue of indefiniteness turns on whether the phrase “substantially all” referring to discrete rather than continuous quantities would be understood by one of ordinary skill. The issue of obviousness turns on whether the art describes replenishing from a designated account and sending a replenishment message to a banking network.

FACTS PERTINENT TO THE ISSUES

Facts Related to the Prior Art

Taskett '237

01. Taskett '237 is directed to a way of adding funds to a prepaid account. Taskett '237: Abstract.

02. Taskett '237 describes various techniques for sending a message requesting replenishment to a banking network.

Taskett '237 14:12-22.

³ Note that the Examiner improperly included claim 33, cancelled by the amendment filed September 30, 2002, in the rejection. Ans. 3.

03.

Taskett '579

04. Taskett '579 is directed to generating and transmitting summary transaction data. Taskett '579: Abstract.

Hanson

05. Hanson is directed to a prepaid telecommunications system.
Hanson: Abstract.

06. Hanson states that the lack of verifying such location identification information in prior art systems was a problem to be solved. Hanson: 2:13-24.

07. Hanson states that "cash, bank drafts, credit cards, and telephone company billing may be used to replenish the prepay wireless account." Hanson: 8:5-23.

ANALYSIS

Claims 29-32, 34, and 12-14 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claim 29 presents an example of what the Examiner found indefinite in receiving a reconciliation message summarizing substantially all individual transactions that occurred during a certain period. The Examiner's point was that in a discrete system, such as with computer data, a quantity is either all or not all, so one of ordinary skill would not understand whether "substantially all" included quantities that were not all. Ans. 3 and 8.

1 The Appellant argued that the word “substantially” has been found to not
2 necessarily render a claim indefinite, citing *In re Nehrenberg*, 280 F.2d 161,
3 164 (CCPA 1960) and *In re Mattison*, 509 F.2d 563, 565 (CCPA 1975).
4 Indefiniteness was not at issue in *Nehrenberg* and the CCPA found that the
5 phrase “to substantially increase the efficiency of the compound” could be
6 understood because the claim

7 further requires that the substituent Ep has an electron
8 withdrawing capacity such that a phenol containing only the
9 substituent Ep has an acid ionization constant K_a of at least 50
10 10-10. The claims must be read in light of the specification. In
11 re Cohn, 438 F.2d 989, 58 CCPA 996 (1971); In re Moore,
12 supra. The specification teaches how the electron-withdrawing
13 substituents must be selected and positioned on the ring in order
14 to provide the desired increase in extraction efficiency at the
15 low pH ranges.

16 *In re Mattison*, 509 F.2d at 565. In the present application, the phrase
17 “substantially all” modifies a number of transactions, which is a discrete
18 quantity, as contrasted with a continuous efficiency quantity in *Mattison*.
19 Further, the instant Specification, far from providing guidelines by which to
20 recognize the scope of the phrase “substantially all,” does not use the word
21 “substantially”, but rather states that “bank 102 sends a reconciliation file
22 summarizing all transactions.” Specification 16:3-4. Thus the claim is
23 indefinite both for making a discrete variable ambiguous as to value and for
24 being in conflict with the Specification.

25 *Claims 12-14, 23, 29-32, and 34-40 rejected under 35 U.S.C. § 103(a) as*
26 *unpatentable over Taskett '237, Taskett '579, and Hanson.*

27 With respect to claim 23, which is similar to claim 29, but also recites
28 “processing replenishment transactions by causing the transfer of said

1 replenishment amounts from a designated source account to said prepaid
2 accounts...” The Appellant argues the art fails to show a designated source
3 account. Appeal Br. 12. We find this argument puzzling as the Appellant
4 recites the passage from Hanson, found on page 8 in lines 5-7, that “cash,
5 bank drafts, credit cards, and telephone company billing may be used to
6 replenish the prepay wireless account.” FF 07. Bank drafts and credit cards
7 all designate specific source accounts on their face.

8 As to independent claims 29, 31, 32 and 34, the Appellant argues that
9 the art fails to show location identification information that identifies
10 authorized replenishment locations, or sending a disbursement message to a
11 bank.

12 The Examiner found that the location identification information was a
13 predictable extension to Hanson, which stated that the lack of verifying
14 customer identification information in prior art systems was a problem to be
15 solved. FF 06. We agree with the Examiner that stating a known problem
16 in the context of the claimed subject matter, where that problem is readily
17 solved by one of ordinary skill, makes that solution predictable. Extending
18 the solution to variants whose only difference is in data that are also
19 appropriate for similar treatment would be predictable variants to the
20 solution. As the need for data verification is shown by Hanson, extending
21 this to verifying the location where replenishment would occur would be
22 seen as a predictable security measure to insure against giving information to
23 false sites.

24 As to sending a disbursement message, Taskett ‘237 describes a caller
25 sending such messages. FF 02. To the extent the Appellant argues the

recipient of the message is not a bank (Appeal Br. 13 and Reply Br. 1-2), claims 29-32 send the disbursement message to a banking *network*, not a bank per se. Claim 34 does refer to a bank rather than a banking network, but the banking network is clearly a tool used by the bank, and since the bank is responsible for the replenishment, the message recipient is within the scope of the bank.

Claim 30 recites verifying that permanent account numbers have been activated. The Examiner makes no finding that the art describes this or that this would be predictable to one of ordinary skill. Thus, the Examiner failed to present a prima facie case as to claim 30.

CONCLUSIONS OF LAW

Rejecting claims 29-32, 34, and 12-14 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is not in error.

Rejecting claims 12-14, 23, 29, 31, 32, and 34-40 under 35 U.S.C. § 103(a) as unpatentable over Taskett '237, Taskett '579, and Hanson is not in error.

Rejecting claim 30 under 35 U.S.C. § 103(a) as unpatentable over Taskett '237, Taskett '579, and Hanson is in error.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 29-32, 34, and 12-14 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is sustained.

1 • The rejection of claims 12-14, 23, 29, 31, 32, and 34-40 under 35
2 U.S.C. § 103(a) as unpatentable over Taskett '237, Taskett '579, and
3 Hanson is sustained.

4 • The rejection of claim 30 under 35 U.S.C. § 103(a) as unpatentable
5 over Taskett '237, Taskett '579, and Hanson is not sustained.

6 No time period for taking any subsequent action in connection with this
7 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
8 § 1.136(a)(1)(iv) (2007).

9

10 AFFIRMED

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